

Application No.: 09/745,927

**REMARKS**

Claims 1, 3-6, 10, 11 and 13-20 are pending in this application.

Claims 1, 3, 5, 10, 11, 13, 15-17 and 19 were rejected under 35 USC §103(a) as being unpatentable over Ostrover et al. (U.S. Patent No. 6,585,154) in view of Porter (U.S. Patent No. 6,533,171). Claim 6 was rejected under 35 USC §103(a) as being unpatentable over Ostrover et al. in view of Klotz, Jr. (U.S. Patent No. 5,459,307). Claim 18 was rejected under 35 USC §103(a) as being unpatentable over Ostrover et al. in view of Choksi et al. (U.S. Patent No. 6,477,243). Claims 4 and 14 were rejected under 35 USC §103(a) as being unpatentable over Ostrover et al. and Porter and further in view of Friedman (U.S. Patent No. 5,417,508). Claim 20 was rejected under 35 USC §103(a) as being unpatentable over Ostrover et al.

The Examiner stated that Ostrover does not disclose expressly that the processor and the computer program are located within the microchip. Rather the processor and the computer program are located with the external computing device, i.e., a computer, printer or copier. The Examiner further stated that Porter discloses an iButton that is capable of storing business card information as well as individual interests, curriculum vitae, a photograph, or other useful information and that it would have been obvious to a person of ordinary skill in the art to replace the microchip of Ostrover with the iButton of Porter; that the iButton and its associated capabilities were well known in the art and therefore it would have been obvious to execute the processes, disclosed by Ostrover as being performed by the computing device, by the iButton. Applicants respectfully disagree.

Claim 1, as previously amended, claims a programmable document, comprising: a physical document including at least one sheet of material and information recorded thereon; and a computer attached to the physical document, wherein the computer includes an input/output device, a memory storing the recorded information in digital form, any updates and modifications to the recorded information, all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information, a processor for updating and modifying the recorded information in digital form

Application No.: 09/745,927

and the metadata pertaining to the physical document, and a computer program, stored in the memory, for implementing defined actions, operable by the processor, wherein the recorded information in digital form and all metadata pertaining to the physical document is available where the physical document is available.

Claim 10, as previously amended, claims a method for managing, retrieving and processing information about a physical document and modifications to the physical document, comprising: providing a computer, wherein the computer includes an input/output device, a processor for updating and modifying information pertaining to the physical document, and a memory; recording information on at least one sheet of material to generate a physical document; storing a digital copy of the recorded information, any updates and modifications to the recorded information, and all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information, in the memory; storing a computer program in the memory, for implementing defined actions, operable by the processor; associating the stored recorded information and metadata with the physical document; and attaching the computer to the physical document, wherein the recorded information in digital form and all metadata pertaining to the physical document is available where the physical document is available.

I. Neither Ostrover nor Porter is concerned with the problem of storing the recorded information and all transformation information pertaining to the recorded information.

Ostrover is concerned with the problem of producing documents with an electronic copy of at least a portion of the content of the document attached thereto (col. 1, lines 56-58). Applicants are concerned with the problem of once the electronic document is printed almost all "meta" information (such as the version number, last date of modification, date of printing, change history, comments, authors, reviewer's ratings, etc.) is lost unless such information is explicitly printed on the document. Applicants are further concerned with the problem of retaining a record of each time a physical document is copied and each time a physical document is modified, such as when modifications are written directly on the paper document. Applicants' programmable document as claimed in Claim 1 and Applicants' method as claimed

Application No.: 09/745,927

in Claim 10 for managing, retrieving and processing information about a physical document and modifications to the physical document combine the advantages of electronic media with the convenience of paper. Applicants' programmable document enables a user to quickly retrieve the electronic version of a document and all associated meta information in any situation where the paper document is available. Applicants' programmable document enables a user to store comments about a paper document and modifications to the document in such a way that they can be retrieved and processed electronically, without having to access expensive computer equipment or a network.

Nothing in Ostrover et al. teaches or suggests a programmable document which includes a computer having, in part, a memory storing the recorded information in digital form, any updates and modifications to the recorded information, all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information.

Porter is concerned with the problem of facilitating the exchange of business cards. Porter teaches storing a business card on a smart card, such as an iButton, in order to facilitate exchange via the internet. Porter teaches inserting two SmartCard devices into a reader simultaneously which automatically starts up an application which reads the details (including electronic addresses) from the two cards. The application then emails the business card details of one participant to the email address of the other, and vice versa. See Porter col. 2, lines 23-32. Porter does not teach storing all metadata pertaining to the physical document, wherein the metadata comprises at least one of processing information, version information, user comments, copy information, transformation information, distribution information and index information on the SmartCard.

Applicants' programmable document combines the advantages of electronic media with the convenience of paper. Applicants' programmable document enables a user to quickly retrieve the electronic version of a document and all associated meta information in any situation where the paper document is available. Applicants' programmable document stores comments about a paper document and modifications to the document in such a way that they can be

Application No.: 09/745,927

retrieved and processed electronically, without having to access expensive computer equipment or a network.

2. Porter teaches away from the use of paper.

Porter teaches eliminating the use of paper business cards. The high rate at which business cards are exchanged can result in a person accumulating an excessive number of cards and to organize the cards into a useful format can be come extremely labor intensive. See Porter col. 1, lines 18-22.

3. The combination of Ostrover and Porter does not teach Applicants' invention.

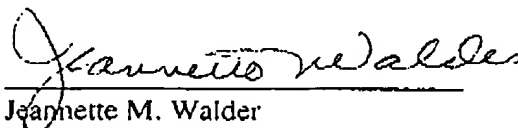
Ostrover teaches attaching an electronic copy of a document in a microchip memory to a hard copy of the document. If one skilled in the art were to combine Ostrover and Porter, one skilled in the art would not get Applicants' invention. At most the teaches of Porter when combined with Ostrover would suggest removing the hard copy of the document since Porter teaches away from the distribution of hard copy business cards.

Independent Claims 1 and 10 are believed to be allowable. Since Claims 3-6 and 16-20 depend from Claim 1 and Claims 11, 13-15 depend from Claim 10, they are also believed to be allowable. Claims 1, 3-6, 10, 11, 13-20 are believed to be in condition for allowance.

No additional fee is believed to be required for this amendment; however, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025.

Reconsideration of this application and allowance thereof are earnestly solicited. In the event the Examiner considers a personal contact advantageous to the disposition of this case, the Examiner is requested to call the undersigned Attorney for Applicants, Jeannette Walder.

Respectfully submitted,



Jeannette M. Walder  
Attorney for Applicants  
Registration No. 30,698  
Telephone: 714-565-1700

Xerox Corporation  
Santa Ana, California  
Date: April 25, 2006